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# Supreme Court of the United States

OCTOBER TERM, 1963

No. 293

CARL W. MULLIS ENGINEERING AND MANUFACTURING COMPANY, INC., *Petitioner*,

versus

THOMAS W. NICHOLSON, *Respondent*

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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Petitioners, Carl W. Mullis, Sr. and Carl W. Mullis Engineering and Manufacturing Company, Inc., seek review of the Decision of the United States Court of Appeals for the Fourth Circuit, in so far as such decision held petitioner's patent No. 2,908,302 invalid as to claim 8 thereof.

## REPORTS OF OPINIONS BELOW

The decision of the United States Court of Appeals for the Fourth Circuit is published at 315 F. 2d. 532, and is also published at 137 USPQ 13. The decision of the District Court is published at 200 F. Supp. 396 and at 132 USPQ 590.

## JURISDICTION

The decision of the Court below, review of which is sought here, was filed on March 6, 1963. A petition for rehearing was filed on April 4, 1963 and was denied on April 25, 1963.

Jurisdiction to review the judgement below is believed to be conferred on this Court by title 28 USC 1254 (1).

## QUESTION PRESENTED FOR REVIEW

The question presented for review is as follows:

Was it proper for the United States Court of Appeals to hold claim 8 of Mullis patent 2,908,302 invalid where:

(1) The District Court had found the claim valid;

(2) The patent relied on by the Court of Appeals in holding the claim invalid was one of those considered by the Examiner in the United States Patent Office;

(3) The expert for the party attacking the validity of the patent admitted that he had never seen any machine embodying the combination claimed in the patent;

(4) The construction and operation of the patented machine was fully explained to the District Court in oral testimony;

(5) No evidence was introduced by the party attacking the validity of the patent as to the equivalency of the structure shown in the prior patent to that covered by the claim held invalid by the Court of Appeals; and

(6) The Judge of the District Court actually saw the patented machine.

## CONSTITUTIONAL PROVISION

The constitutional provision which the case involves is as follows:

> Art. 1, Sec. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

## STATUTORY PROVISIONS

The statutes which the case involves are as follows:

28 U. S. C. 1338. *Patents, copyrights, trademarks and unfair competition.* (a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases.

28 U. S. C. 1291. *Final decisions of district courts.* The courts of appeals shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the United States District Court for the District of the Canal

Zone, the District Court of Guam, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court.

28 U. S. C. 1292. *Interlocutory decisions.* (a) The courts of appeals shall have jurisdiction of appeals from:

(4) Judgments in civil actions for patent infringements which are final except for accounting. . . .

35 U. S. C. 282. *Presumption of validity; defenses*

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

35 U. S. C. 102. *Conditions for patentability; novelty and loss of right to patent*

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,

## STATEMENT OF THE CASE

### (1) Procedure Below

This suit was originally filed by Thomas W. Nicholson as plaintiff against Carl W. Mullis Engineering and Manufacturing Company Inc as defendant charging infringement of two patents owned by Nicholson. The petitioner herein, Carl W. Mullis Engineering and

Manufacturing Company Inc. and the intervenor, Carl W. Mullis, Sr., president of the corporation and inventor and owner of patent number 2,908,302, counterclaimed against Nicholson for infringement of claim 8 of such patent.

It is because petitioners here, the holders of the patent, were the defendants below that we have referred above to Nicholson as the party attacking the validity of the patent.

Hereinafter, the parties will be referred to as Mullis and Nicholson respectively.

After a full trial on the merits, the District Courts found that the claim 8 of the Mullis patent, the only one in suit, was valid and was infringed by a machine being manufactured by Nicholson. Such machine was substantially different from the machines shown in the Nicholson patents on which the suit was originally instituted. The District Court also found that the Nicholson patents were not valid and were not infringed by the Mullis machine. Nicholson thereupon appealed to the United States Court of Appeals for the Fourth Circuit, which after argument, held that the District Court was correct in every respect except in its holding that claim 8 of the Mullis patent was valid. The Court of Appeals held that this claim was invalid in view of a Brundell patent number 2,786,499, which had been one of the patents relied on by Nicholson in attacking the validity of the Mullis patent. A copy of the Brundell patent is attached to this petition.

The Brundell patent was, as is shown by the list of references at the back of the Mullis patent, a copy of which is attached to this petition, cited and relied upon

by the Examiner in the Patent Office during the prosecution of the application resulting in the Mullis patent.

**(2) The Mullis Patent**

The Mullis patent 2,908,302 relates to a device for removing bark from logs. In this device, the logs are fed lengthwise through a rotating drum by feed rolls which prevent the logs from rotating. The drum has on its interior a set of inwardly directed arms carrying debarking tools, which scrape the bark off the log as it passes through the drum.

This general type of log debarking device was not invented by Mullis.

The Mullis machine, as best seen perhaps in Fig. 5 of the patent, includes a rotating drum of annular shape, indicated at 104.* Pivoted at 212 on a framework which rotates with the drum are the arms 216, which extend inwardly towards the center of the drum. At their inner ends, these arms carry debarking tools or scrapers 224, 228.

The arms are pushed inwardly by pistons 250 (see Fig. 8) slidable in cylinders 232 set into the inner wall 106 of the drum 104. These pistons are connected by the piston rods 252 to the arms.

In operation, the rotating tank 104 is filled with air under pressure. This air acting on the pistons 250 exerts an inward pressure so as to hold the tools against the logs. However, because of the compres-

* Reference characters referred to herein are encircled in red on the copies of the patents.

sibility of the air in the tank, the arms are capable of being pushed outwardly.

The arms are askew shaped as is shown in Figs. 7 and 8. That is, they have a backwardly curved edge. The purpose of this is to enable the arms to the opened by oncoming logs, since the logs push against the slanted edge of the rotating arm, and the slanted curved edge causes the arm to be cammed outwardly, until the tools can come up on the log. They are then pressed against the log by the pressure in tank 104 acting through pistons 250.

The result of this is that, whether or not the logs follow close upon each other, any log arriving at the drum will cause the tools to open to receive it, and then will pass through the drum and be debarked.

In prior devices using gas under pressure as a source of the force needed to hold the tools against the log, the usual construction had been one in which the gas was supplied from a stationary source, which required rather complicated sealing arrangements between the drum and the stationary frame, which were expensive and subject to substantial leakage. Mullis on the other hand has a self contained source of gas under pressure within his tank, so that the necessity of complicated sealing arrangements is avoided.

Likewise, Mullis avoids the necessity, which was usual in prior constructions having an outside source of gas under pressure, of having any valve arrangement for supplying gas under pressure to the ring in such a way as to produce the opening of the arms so that they can open and then engage against the outside of an oncoming log.

**(3) The Brundell Patent**

The Court of Appeals found claim 8 of the Mullis patent invalid in the light of the Brundell patent 2,786,499.

That patent shows a ring type of debarker. In Fig. 1, the ring is indicated at 10 and has pivoted arms 13 which carry scraping tools at their inner ends. These arms are askew, that is, they will be automatically opened by an oncoming log.

However, in order to furnish the pressure needed for holding the tools against the log, Brundell uses rubber bands shown at 28 in Fig. 1.

In the modifications shown in Fig. 1b of Brundell, the rubber band is shown at 148. In this modification, cylinder 140 contains a liquid, such as oil, and the rubber band is connected by a rod 144 to a piston 142 within the cylinder 140. There are provided as many of these cylinders 140 as there are arms, each connected to the arm through a rubber band. The cylinders are interconnected by a pipe 160, so that, as in Mullis, there will be equalization of pressure between the various rubber bands.

The rubber bands act on arms 26 (Fig. 1b) which are connected to the shafts 20 which carry the arms 13.

In the Brundell patent, the force for holding the arms inward so as to force the tools against the log is provided by the stretching of the rubber bands. The oil in the cylinders 140 is incompressible, and serves merely as a mechanical connection between the various rubber bands to maintain them at substantially the same tension. This is true because oil is an incom-

pressible material, and cannot act as a source of pressure in any way comparable to the compressible air which is used in the Mullis machine and which furnishes the resilient pressure necessary for holding the tools against the logs.

## GROUNDS FOR GRANTING CERTIORARI

The Decision of the Court of Appeals in this case constitutes the decision of a Federal question in a way in conflict with applicable decisions of this Court, and also so far departs from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

### (1) Case Was Not Submitted Purely On Documentary Evidence

The Court of Appeals, in relying on that case, said, in respect to the holding of validity by the lower Court:

> "His [the District Court's] conclusion was not evolved from conflicting testimony but rather upon a comparative reading of the patents. Inasmuch as these documents are equally as available to us, the resolution of the question of patent validity by the trial court is not as binding here as would be a factual ascertainment upon varying evidence under Rule 52(a) F.R.Civ. P., Kiwi Coders Corp. v. Acro Tool & Die Works, 250 F. 2d 562 (7 Cir., 1957). Our examination convinces us that Brundell's patent, No. 2,786,499, filed March 22, 1954, issued March 26, 1957 clearly anticipated Mullis."

Petitioner submits that the law as laid down in *Kiwi Coders Corporation* v. *Acro Tool and Die Works*, is improperly applied in this case.

In the present case, the Court actually saw the Mullis machine after the trial and before rendering his

opinion. Likewise, there is evidence by Nicholson's own witness, Holekamp, (App. 3a, 4a, 5a)* who was quite well acquainted with the machines in the field, and who apparently was familiar with the Cambio Machine constructed according to the Brundell patent, that he had never seen a machine having the various features of the Mullis machine in combination. And Mullis himself testified to the structure and operation of the Mullis machine (App. 5a to 29a, especially 21a to 22a). Thus there was evidence before the District Court from which it could be concluded that there was a substantial difference between the Brundell machine and the machine of the Mullis patent, and the Appellate Court's conclusion that its action in reversing the District Court was justified because the case was dependent purely on documentary evidence is unwarranted.

**(2) Presumption of Correctness of Lower Court's Findings**

It hardly seems necessary to cite authority to the fact that the District Court's findings and conclusions are not to be set aside unless clearly erroneous.

As this Court said in *Graver Tank Co.* v. *Linde Air Products*, 336 U.S. 271, at pages 274, 275, 279, this applies as well to findings in favor of the patent as to findings against the patent. The Court there said:

> "Rule 52 (a) of the Federal Rules of Civil Procedure provides in part: Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses.
>
> * * * * * * * * *

* The appendix contains all that part of the transcript relating in any way to the Mullis patent.

To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations.

* * * * * * * * *

The rule requires that an appellate court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only "clearly erroneous" findings. These are manifestly supported by substantial evidence and the Court of Appeals found them supported by the weight of the evidence—indeed found the evidence to warrant support of the patent even in matters not found by the trial court.

* * * * * * * * *

The same deference is due to the findings of the trial court which overturn claims as to those which sustain them."

And, as the Supreme Court held in *Commissioner* v. *Duberstein*, 366 U.S. 278, at page 291.

"The rule applies itself also to factual inferences from undisputed basic facts."

The District Court drew the conclusion from the facts that the Mullis patent was valid.

It is true that the District Court made an error in failing to appreciate that the Brundell patent showed in Fig. 1b an arrangement in which the pressure on the arms was equalized by an interconnection between them. However, the Court also found that *Brundell applies the force to the arms by a separate rubber band or the like for each arm* (Finding 60). This in itself distinguishes the subject matter of claim 8, which the

District Court characterized as having a source of pressure fluid carried by the ring, and more particularly, as the Court stated in its opinion:

> "Mullis devised a machine which incorporated a number of features which Nicholson's own expert admitted he had never seen before in combination. It has a source of pressure fluid carried by the ring, so that no outside supply is needed, and there are no sealing joints required between the ring and the stationary part of the machine. The source is connected to all cylinders so that the pressure is equalized on all the tool-carrying arms. The arms are "askew", that is, they have curved front edges so that, when the butt end of a log strikes them, they open automatically and apply the tool to the log.
>
> No patent in the prior art and no machine known to plaintiff or his expert, has a self-contained reservoir of pressure fluid in the ring connected to all the cylinders with self-opening askew arms. This combination was new and I find the Mullis patent valid."

We submit then that, despite the fact that there was an error in one finding of the District Court, this error was irrelevant and immaterial, since there is no evidence in the record whatsoever that the rubber bands of Brundell, which furnish the force for pressing the tools against the log, are in any way the equivalent of the reservoir of compressed air which Mullis uses.

The party Nicholson did not choose to do any more before the District Court than merely put in evidence the patents on which he relied to invalidate claim 8 of Mullis. No evidence was offered by him as to the applicability of the references to the claim, and there was no showing of that of claim 8 of Mullis. We sub-

mit that under these circumstances an Appellate Court is not warranted in upsetting the opinion of the District Court.

We further submit that the opinion of the Court of Appeals in this respect is entirely unwarranted by the facts. The Court was clearly in error in stating "Brundell used rubber bands as a connection to hold the cutting arms and tool in place". The rubber bands of Brundell *are not used as a connection at all but as a force supplying means.* Brundell can raise the tension of these rubber bands by forcing liquid into the cylinders, which is equivalent to moving the pivot points of the rubber bands by an adjusting arrangement such as is shown in Fig. 1a. However, in both cases *it is the rubber bands themselves which furnish the force.*

This is clear from the specification of the Brundell patent, which in column 1, line 29 refers to "The use of solid elastic materials for the actuation of each tool"; and in lines 37 to 38 where he refers to the fact that "the stretching of elongate, elastic material will produce tensile stress". In line 41 he refers to the "resilient elastic force". In column 3, lines 67 to 68, Brundell states that the "endless rubber band constitutes an elastically deformable means for applying force to the tools during debarking". In the claims, for example in column 5, lines 71 to 72, the patentee calls for a "solid elastic-rubber material means . . . for applying a resilient turning and actuating force to each of the shafts".

It is thus clear that the language of the Brundell patent belies the position of the Court of Appeals.

**(3) The Mullis Patent Claim Should Be Interpreted To Hold It Valid If Possible**

Claim 8 of the Mullis patent uses the term "a fluid under pressure". While this might conceivably be interpreted to mean a liquid under the pressure of a rubber band, we submit that, in conjunction with the specification which discloses a gas only, it should be construed to mean a gas, and this was what the District Court below meant, we submit, when it referred in its opinion to "a source of pressure fluid". And it is not necessary to interpret the term "fluid under pressure" in claim 8 of Mullis to include a liquid in order to make out infringement of the Mullis patent by Nicholson, since Nicholson's Accumat machine also uses a gas under pressure.

Patent claims should be construed to validate them if possible, and recourse to the specification and drawing is proper to determine the concept intended by the language of the claims.

This has been the constant position of this Court (*Coupe* v. *Royer*, 155 U.S. 565, 577).

In *Scherbatskoy* v. *United States Steel Corp.*, 287 F.2d 552, at page 556, the Court (USCA 7th) said:

> 'And, in the instant case, recourse to the specification and drawing was proper, if not necessary, to determine the concept intended by 'relative motion', 'indicating the displacement', 'indicating various portions', and 'distinguishable characteristics' in the context in which such phraseology was employed. Cf. Permo, Inc. v. Hudson-Ross, Inc., 7 Cir., 179 F.2d 386, 388; Grubman Engineering & Mfg. Co. v. Goldberger, 2 Cir., 47 F.2d 151.'

See also the decision of the Fourth Circuit in *Long Mfg. Co.* v. *Holiday*, 246 F.2d 95, 99:

> "(1) An inventor has a right to define specific terms as used in a patent; and while the drawings and specifications may not enlarge the scope of the claims, they may be considered in determining the inventor's definition of the terms he employed. Black & Decker Mfg. Co. v. Baltimore Truck Tire Service Corporation, 4 Cir., 40 F.2d 910; Hutzler Bros. Co. v. Sales Affiliates, Inc., 4 Cir., 164 F.2d 260; City of Grafton, W. Va. v. Otis Elevator Co., 4 Cir., 166 F.2d 816."

**(4) Presumption of Validity**

The patent statute, 35 U.S.C. 282, states that a patent is presumed to be valid. And this presumption is recognized as being strengthened where, as here, the prior art has been considered by the Patent Office as is shown by the list of references on the back of the Mullis patent.

This rule has been recognized by this Court, in *Hildreth* v. *Mastoras*, 257 U.S. 27. It is recognized in all the ten circuits, and specifically in the Fourth Circuit (*Brown* v. *Brock*, 240 F.2d 723, 727).

## CONCLUSION

It is submitted that, where the party attacking the patent has chosen not to present any evidence showing the equivalency of what is shown in the prior art to what is claimed, he should not be allowed to benefit from this to the extent of obtaining a holding of invalidity in the Court of Appeals on the basis of the theory that his part of the case is dependent solely on documentary evidence.

Especially he should not prevail when there is evidence presented by the patent owner, and where reversal of the District Court runs contrary to the presumptions *both* of the correctness of its findings *and* of the validity of the patent, strengthened by the consideration by the Patent Office of the prior art relied on by the Court of Appeals.

Respectfully submitted,

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